



<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  <b>3584-6</b>
	Application Number  <b>09/987,438</b>	Filed  <b>November 14, 2001</b>
	First Named Inventor  <b>WIRTH, Jr.</b>	
	Art Unit  <b>3622</b>	Examiner  <b>Janvier, Jean D.</b>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>		
<div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <p>I am the</p> <p><input type="checkbox"/> Applicant/Inventor</p> <p><input type="checkbox"/> Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> Attorney or agent of record <u>29,834</u> (Reg. No.)</p> <p><input type="checkbox"/> Attorney or agent acting under 37CFR 1.34. Registration number if acting under 37 C.F.R. § 1.34 _____</p> </div> <div style="width: 50%; text-align: center;"> <p><u>Robert A. Molan</u> Signature</p> <p>Robert A. Molan</p> <hr/> <p>Typed or printed name</p> <p><u>703-816-4038</u> Requester's telephone number</p> <p><u>March 31, 2006</u> Date</p> </div> </div> <p><b>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*</b></p> <p><input checked="" type="checkbox"/> *Total of <b>1</b> form/s are submitted.</p>		

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

WIRTH

Atty. Ref.: 3584-6; Confirmation No. 5430

Appl. No. 09/987,438

TC/A.U. 3622

Filed: November 14, 2001

Examiner: Janvier, Jean D.

For: METHOD AND SYSTEM FOR USING DIRECT MAIL TO PERSUADE CUSTOMERS  
TO ACCESS AND PLACE ORDERS ON AN E-COMMERCE WEBSITE

\* \* \* \* \*

March 31, 2006

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Sir:

**STATEMENT OF ARGUMENTS IN SUPPORT OF  
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicant respectfully requests a pre-appeal brief review to determine whether the Examiner's rejection of claims 1 – 52 under §103(a) in the Final Office Action mailed in the above-identified application on October 31, 2005 is legally and factually sufficient.

In the Final Office Action mailed on October 31, 2005, the Examiner rejected claims 1 – 52 under 35 U.S.C. §103(a) as being unpatentable over *Shane* (U.S. Patent No. 5,793,972) in view of *Bezos* (U.S. Patent No. 6,029,141). *See* October 31, 2005 Final Office Action, pp. 3 – 14. The Examiner's reasons for his current rejection of claims 1 – 52 are substantially the same as those advanced by the Examiner in the September 28, 2004 Office Action in support of his rejection of claims 1 – 52 under 35 U.S.C. §103(a). *See* September 28, 2004 Office Action, pp. 3 – 14. Applicant responded to the September 28, 2004 Office Action by an Amendment filed February 23, 2005, and to the Final Office Action by a Response To Final Rejection filed

WIRTH  
Appl. No. 09/987,438  
March 31, 2006

January 31, 2006. The following explains the clear errors in the Examiner's final rejection of claims 1 – 52 under §103(a) in the October 31, 2005 Final Office Action, so as to be legally and factually deficient.

Applicant contends that the Examiner's rejection of claims 1 – 52 under §103(a) in the Final Office Action is (1) legally deficient because the Examiner failed to provide a sufficient reason as to why one of ordinary skill in the relevant art would have selected the elements from the cited *Shane* and *Bezos* references and combine them in the manner argued by the Examiner to produce the claimed invention, and (2) factually deficient because, even assuming, *arguendo*, that the Examiner properly combined the cited *Shane* and *Bezos* references, such references do not, either alone or in combination, teach or suggest all of the elements of the rejected claims, particularly those of independent claims 1, 25 and 39.

For a claimed invention to be obvious over a combination of prior art references, there must be some suggestion, motivation or teaching in the prior art that would have led one of ordinary skill in the art to combine the references to produce the claimed invention. *E.g., Ashland Oil, Inc. v. Delta Resins & Refracs.*, 776 F.2d 281, 293 (Fed. Cir. 1985). In this regard, the Federal Circuit has warned against using a claimed invention as a “blueprint” for piecing together elements in the prior art to defeat the patentability of a claimed invention. *In re Rouffet*, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). The Federal Circuit has identified three possible sources for a motivation to combine references, *i.e.*, “the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *Id.* at 1457-58 (Fed. Cir. 1998).

In combining the *Shane* and *Bezos* references to reject claims 1 – 52 under §103(a), the Examiner did not rely on any of the three possible sources of motivation to combine identified by the Federal Circuit. Rather, the Examiner merely stated that “an ordinary skilled artisan would

have been motivated at the time of the invention to incorporate the *Bezos*' [sic] teachings into the system of *Shane* so as to . . .", whereupon the Examiner then provided a description of the *Bezos* system in the form of a single sentence that spans three pages of the Final Office Action. See October 31, 2005 Final Office Action, pp.10 through 12. It is respectfully submitted that, in doing so, the Examiner has failed in his burden of demonstrating why one of ordinary skill in the art would combine these references so as to render claims 1 – 52 obvious over *Shane* and *Bezos*.

But, whether or not the Examiner properly combined *Shane* and *Bezos*, these references, either alone or in combination, do not teach or suggest at least three of the elements recited in rejected independent claims 1, 25 and 39, *i.e.*, (1) a mailer for each potential customer having printed on it a login name for the potential customer that includes the potential customer's name, (2) a program that, when a potential customer's login name is compared with stored names, allows the matching of the login name with stored names, even in instances of mis-keyed or misspelled name entries, and (3) transmitting a standard welcome is to a potential customer, even where the potential customer's login name does not correspond to a stored name, thereby allowing access to the E-commerce website by such customers. They also do not disclose or suggest the high visibility mailer recited in independent claim 25, which is designed to get the attention of a potential customer to which it is mailed. See February 23, 2005 Amendment, pp. 20 – 23, and January 31, 2006 Response to Final Rejection, pp. 3 – 6.

*Shane* discloses a system and method for providing an interactive response to direct mail (1) that includes a mailer with a URL containing a personal identification code for the recipient that is numerical in nature, (2) that displays a message that a submitted personal identification code could not be found and to try again where a correctly formatted personal identification code has been entered, but no matching personal identification code has been is found, and (3) that

WIRTH  
Appl. No. 09/987,438  
March 31, 2006

ultimately displays a message that access to the personalized web server is temporarily unavailable, when too many unauthorized access attempts have been made. *See* February 23, 2005 Amendment, pp. 21 – 22, and January 31, 2006 Response to Final Rejection, pp. 4 – 6.

*Shane* also does not teach or suggest the use of a high visibility mailer that is designed to get the attention of a potential customer. In one embodiment of the high visibility mailer, a post card stock is chosen having a color that contrasts with the printed letters used on the post card. The example given in the present application is a post card chosen to be a bright orange color with sharp contrast with the black lettering used for the mailing names and addresses. *See* February 23, 2005 Amendment, pp. 20 – 23, and January 31, 2006 Response to Final Rejection, pp. 4 – 7.

*Bezos et al.* do not compensate for the above-noted deficiencies in the teachings of *Shane*. *Bezos et al.* do not disclose a method of inducing potential customers to place orders via a telecommunications network. Rather, *Bezos et al.* disclose an Internet-based customer referral system that enables individuals and other business entities to market products, in return for a commission, that are sold from a merchant's website. *See* February 23, 2005 Amendment, p. 23, and January 31, 2006 Response to Final Rejection, pp. 6 – 7.

The Examiner's reliance on "Official Notice" to support his rejection of claims 6, 7, 9, 12 – 15, 29, 30, 31 and 41 – 45 under §103(a) in the Final Office Action is also legally deficient. When an Examiner makes a patentability determination that a claimed invention is obvious over the prior art, the Examiner must rely on "concrete factual evidence" to make the factual findings to support a §103(a) rejection. *See In re Zurko*, 258 Fed.3d 1379, 1385-86 (Fed. Cir. 2001). The Examiner has not met this burden. Nor has the Examiner, in his reliance on Official Notice, met his burden of showing that the "facts" asserted to be well known, are

WIRTH  
Appl. No. 09/987,438  
March 31, 2006

capable of "instant and unquestionable demonstration as being well-known." MPEP §2244.03.

*See* January 31, 2006 Response to Final Rejection, pp. 7 – 10.

In view of the foregoing, the Examiner's obviousness rejection of claims 1 – 52 is untenable, as there is no support for the obviousness rejections of independent claims 1, 25 and 39, or the claims depending from them, *i.e.*, claims 2 – 24, 26 – 38 and 40 – 52.

Based on the foregoing, Applicant believes that a pre-appeal brief review is appropriate to determine whether the Examiner's rejection of claims 1 – 52 under §103(a) in the Final Office Action is legally and factually sufficient. Applicant submits that the remarks made in its January 31, 2006 Response To Final Rejection sufficiently rebut the Examiner's obviousness rejection of claims 1 – 52.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

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